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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/700,511

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Mohan G. Kulkarni

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07/24/2008

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ALEXANDRIA, VA 22314

EXAMINER

PEZZUTO, HELEN LEE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

07/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/700,511

**Applicant(s)**

KULKARNI ET AL.

**Examiner**

Helen L. Pezzuto

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-53 is/are pending in the application.
- 4a) Of the above claim(s) 50-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 46-53 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Inventor's Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 50-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/11/06.

***Claim Rejections - 35 USC § 102/103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 46-49 are rejected under 35 U.S.C. 102(b) or 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fischer (US-810) or Chisholm et al. (US-068) for the reasons of record.

US 4,645,810 to Fischer discloses and exemplifies an adhesive composition derived from 100 parts of monofunctional methacrylate (a), 50-200 parts of hydroxymethacrylate (b), and not more than 20 parts of a dimethacrylate (c). Prior art (a) and (b) are within the scope of the instant A monomer and prior art (c) is within the scope of the instant B monomer as claimed (col. 3, lines 23-67; working Examples). Thus, anticipating the present claims.

US 6,646,068 to Chisholm et al. discloses and exemplifies soluble branched copolymer suitably used as surface coating, comprising a monofunctional monomer and 0.3-100 w/w% of a polyfunctional monomer defined within the scope of applicant's A and B monomers (col. 2, lines 13-25; col. 3, line 7 to col. 4, line 37; working Examples).

Regarding the recited "only one unsaturated site has taken part in polymerization" pertaining to monomer B, the

examiner is of the position that such characteristics is considered inherent in prior art polymerization process, or at the least would be expected to occur to a certain extent. The burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. In any event, it would have been obvious to one having ordinary skill in the art to control the relative reactive ratios of various monomer components so as to obtain a copolymer product with the desirable recurring units and architecture.

***Claim Rejections - 35 USC § 103***

5. Claims 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blackwell (US-559) or Attarwala et al. (US-320) for the reasons of record.

US 5,756,559 to Blackwell et al. discloses an adhesive composition comprising at least one polymerizable acrylate compound (col. 3, lines 4-21), including one or more monofunctional or polyfunctional acrylate monomers (col. 5, line 38 to col. 6, line 54; col. 8, lines 3-34) defined within the scope of the present claims.

Similarly, US 6,727,320 to Attarwala et al. discloses an adhesive/sealant composition. Suitable polymerizable monomers include mixture of monofunctional and

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polyfunctional (meth)acrylate monomers taught within the scope of the instant claims ( col. 4, line 64 to col. 6, lines 46).

Since prior art discussed above teach copolymer systems derived from mixture of monofunctional and polyfunctional monomers as expressed in the present claims. Accordingly, one having ordinary skill in the art would have readily envisaged selecting a mixture of the monofunctional and polyfunctional ethylenically unsaturated monomers as taught to be functional/operational in the preparation of prior art copolymer, motivated by the reasonable expectation of success in making adhesive composition. Thus, rendering obvious the present claims.

***Response to Arguments***

6. Applicant's arguments filed 2/11/08 have been fully considered but they are not persuasive. The crux of applicant's lies in prior art polyfunctional monomers are used as crosslinker and hence more than one unsaturated site is expected to take part in polymerization. The examiner respectfully disagrees. Taken the broadest interpretation of unsaturated site, and depending on the amount and type of polyfunctional monomers used, one would not expect all unsaturated sites to participate in the polymerization. Applicant further urges the

differences in polymerization mechanism in producing the instant polymer product and prior art polymer product. The examiner is of the position that the patentability of invention is determined based on the product itself, not the process of making it. Accordingly, the examiner's position is maintained.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Helen L. Pezzuto/  
Primary Examiner  
Art Unit 1796

Hlp



**Application Number****Application/Control No.**

10/700,511

**Examiner**

Helen L. Pezzuto

**Applicant(s)/Patent under  
Reexamination**

KULKARNI ET AL.

**Art Unit**

1796